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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,988	10/21/2003	Andrew Sean Gordon Daly		3985

466 7590 11/16/2006

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EXAMINER

ALI, SHUMAYA B

ART UNIT	PAPER NUMBER
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3771

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,988

Applicant(s)

DALY, ANDREW SEAN GORDON

Examiner

Shumaya B. Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/11/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of figure 5 in the reply filed on 4/11/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 0225220.3, filed on 10/30/2002.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words (**Applicant's abstract contains 180 words**). It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Line 10 recites "posterior side of the joint"; however there is not previous recitation of an anterior side of the joint in the claim. Therefore, without positively reciting an anterior side the posterior side is considered indefinite.

Claim 1 recites the limitation "the posterior" in lines 9 and 10. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "one collar" in lines 4. There is insufficient antecedent basis for this limitation in the claim because claim 1, which claim 8 depends from cites first and second collars, therefore first or second collars do not positively recite "one collar" of claim 8.

Regarding claim 11, claim 11 does not further limit structure of parent claim. Furthermore claim 11 recites intended use of a tendon and ligament support without further limiting structures associated with such use. Thus, metes and bounds of claim limitation are considered vague.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Neblon US Patent No. 5,383,845

As to claim 1, Neblon in a hinged orthopedic brace discloses a tendon and ligament support (device of figures 5-7) for a limb joint comprising a first limb embracing collar and a second limb embracing collar (22,28), a connection means (36) for providing articulation and separation between the two collars, and means (70,72) for securing the collars so as to embrace the limb respectively above and below the joint; characterized in that the connection means is adapted to provide limited ligament and or tendon elongation under load and further discloses means (14,16) arranged to the posterior side of the joint so as to exert a resistance to movement over a predetermined range of joint rotation.

As to claim 2, Neblon discloses wherein the resistance exerting means includes adjustment means (46) to vary the amount of resistance exerted to said joint movement.

As to claim 3, Neblon discloses wherein the resistance exerting means is arranged; to prevent joint movement beyond said predetermined critical amount of joint rotation, or to exert progressively increasing resistance to joint movement as the joint rotates under downward pressure, or to exert no resistance to joint movement until the joint rotates beyond a predetermined critical amount of joint rotation, or to exert total resistance to joint movement in both flexion and extension when so required (col.7 lines 17-28).

As to claim 4, Neblon discloses the connection means accommodate limited lateral joint movement (col.7 lines 7-14).

As to claim 5, Neblon discloses the connection means includes one or more hinges (figs. 6 and 7, 36).

As to claim 6, Neblon discloses the resistance exerting means is provided by a brake or by a stop to prevent joint movement beyond said predetermined critical amount of joint rotation (col.7 lines 7-14).

As to claim 7, Neblon discloses the resistance exerting means is provided by a connector of high tensile strength and limited elasticity connected to one or more points on each of the first limb embracing collar and the second limb embracing collar, preferably adapted so as to mimic an artificial tendon or ligament arrangement (col.7 lines 7-14).

As to claim 8, Neblon discloses the resistance-exerting means comprises a compressible member (16) mounted against a support (46) on one collar; a compressible member engaging means (44,52) embracing the member between itself and the support and connected to the other collar whereby pivoting movement of one collar away from the other causes the member to be compressed.

As to claim 11, Neblon's device is fully capable of being a tendon and ligament support when adapted as a support for a horse's fetlock joint (col.6 lines 55-64).

As to claim 12, Neblon discloses that at least one of said collars further comprises a panel (12) constructed from shock absorbent composite materials adapted to provide protection to a horse's fore leg against over reach striking by the horse's hind leg.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neblon US Patent No. 2,883,982 in view of Gerig US Patent No. 5,897,520.

As to claim 10, Neblon discloses claimed invention as applied to claim 1 with the exception of either collars comprise air intake entrance at the front face of the device, and or comprise channels to allow to allow coolant gas or liquid pass from one part of the device to another. However, Gerig teaches a leg-supporting device with aperture for providing ventilation to the anterior portion of the wearer's leg, thereby providing a

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desired level of comfort (see col.5 lines 7-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Neblon's collar with a ventilation aperture as taught by Gerig in order to provide ventilation through the collar to further enhance wearer's comfort.

Conclusion

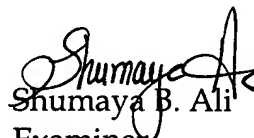
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4,726,361, US 4,726,361, US 5,031,607, US 5,115,627, US 2,83,982, and US 3,913,302 are cited to teach tendon/ligament and joint supporting device.

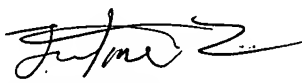
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-W-F 8:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Shumaya B. Ali
Examiner
Art Unit 3771
11/12/2006


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11/12/06